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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,479	01/25/2002	Peter Ottersbach	215505US0XPCT	5661

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EXAMINER

BERMAN, SUSAN W

ART UNIT PAPER NUMBER

1711

DATE MAILED: 03/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,479

Applicant(s)

OTTERSBACK ET AL.

Examiner

Susan W Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 23-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 78.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 10-14 and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohmae et al (5,208,016). Ohmae et al disclose antimicrobial substances and process for making them. Example 8 discloses a copolymer of dimethylaminoethyl methacrylate (component I), dimethylaminopropyl acrylamide (component II) and ethylene. Uses for the copolymers are taught in column 5, line 59, to column 6, line 3.

Claims 1-18 and 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 862 858. EP '858 discloses antimicrobial polymers prepared by polymerizing tert.-butylaminoethyl methacrylate and other ethylenically unsaturated monomers "B" having a formula taught on page 3, lines 14-29. Additional ethylenically unsaturated monomers, including primary, secondary and tertiary amino group containing monomers are taught. Copolymerization can occur directly onto a substrate surface. Graft polymerization employing a chemical initiator or radiation is disclosed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 862 858 in view of Ohmae et al. EP '858 discloses antimicrobial polymers prepared by polymerizing tert.-

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butylaminoethyl methacrylate and other ethylenically unsaturated monomers "B" having a formula taught on page 3, lines 14-29. Additional ethylenically unsaturated monomers, including primary, secondary and tertiary amino group containing monomers are taught. Copolymerization can occur directly onto a substrate surface. Graft polymerization employing a chemical initiator or radiation is disclosed. It would have been obvious to one skilled in the art at the time of the invention to prepare a polymer using two different secondary amino ethylenically unsaturated compounds selected from those taught by Ohmae et al in the copolymer and process for making taught by EP '858. One of ordinary skill in the art at the time of the invention would have been motivated by a reasonable expectation of providing a useful antimicrobial polymers because Ohmae et al and EP '858 teach that any of the monomers of the disclosed formula are suitable and equivalent for providing antimicrobial polymers.

Claims 1-18 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ottersbach et al (5,967,714). Ottersbach et al disclose antimicrobial polymers prepared by polymerizing tert.-butylaminoethyl methacrylate and other ethylenically unsaturated monomers "B" having a formula taught in column 2, line 58, to column 3, line 11. Copolymerization can occur directly onto a substrate surface. Graft polymerization employing radiation is disclosed. It would have been obvious to one skilled in the art at the time of the invention to prepare a polymer using two different secondary amino ethylenically unsaturated compounds selected from those taught by Ottersbach et al and including tert.-butylamino methacrylate. One of ordinary skill in the art at the time of the invention would have been motivated by a reasonable expectation of providing a useful antimicrobial polymers because Ottersbach et al teach that any the monomers of the disclosed formula are suitable and equivalent for providing antimicrobial polymers.

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Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-18 and 23-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,967,714. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art at the time of the invention to employ compounds containing secondary amino groups as the other aliphatically unsaturated monomer to be polymerized with tert.-butylaminoethyl methacrylate in the method and coated articles set forth in the claims. The reason is that Such monomers are within the formula for compounds "B" set forth in the disclosure as being suitable aliphatically unsaturated monomer to be polymerized with tert.-butylaminoethyl methacrylate useful in the claimed method and articles.

Claims 1-18 and 23-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 09/926470. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copolymer and process of SN '813 and the polymer and process in the instant claims

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require polymerizing ethylenically unsaturated monomers containing an amino group to prepare an antimicrobial polymer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-18 and 23-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 09/926471. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process of SN '471 and the process in the instant claims require polymerizing ethylenically unsaturated monomers containing an amino group to prepare an antimicrobial polymer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-18 and 23-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 09/926507. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process of SN '507 and the process in the instant claims require polymerizing ethylenically unsaturated monomers containing an amino group to prepare an antimicrobial polymer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-18 and 23-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 09/926508. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process of SN '508 and the process in the instant claims require polymerizing ethylenically unsaturated monomers containing an amino group to prepare an antimicrobial polymer.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-18 and 23-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 09/926510. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process of SN '510 and the process in the instant claims require polymerizing ethylenically unsaturated monomers containing an amino group to prepare an antimicrobial polymer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-18 and 23-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10/070813. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copolymer and process of SN '813 and the polymer and process in the instant claims require polymerizing ethylenically unsaturated monomers containing an amino group to prepare an antimicrobial polymer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-18 and 23-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10/070817. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copolymer and process of SN '817 and the polymer and process in the instant claims require polymerizing ethylenically unsaturated monomers containing an ester group and an amino group to prepare an antimicrobial polymer.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-18 and 23-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10/069562. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copolymer and process of SN '562 and the polymer and process in the instant claims require polymerizing ethylenically unsaturated monomers containing an ester group and an amino group to prepare an antimicrobial polymer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9310 for regular communications and 703 872 9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.



Susan W Berman
Primary Examiner
Art Unit 1711

SB
March 23, 2003